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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,585	02/09/2001	Colin Leslie Young	032642-004	5719

21839 7590 09/29/2003

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EXAMINER

PAK, JOHN D

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 09/29/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/762,585

Applicant(s)

YOUNG, COLIN LESLIE

Examiner

JOHN D PAK

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 55-96 is/are pending in the application.
- 4a) Of the above claim(s) 96 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 55-96 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/28/03 has been entered.

The restriction requirement made in Paper No. 6 (7/2/02) and applicant's election of Group I (claims 55-95) carry over in this application in the absence of contrary indication by applicant. Claims 55-95 will presently be examined, and claim 96 is withdrawn from further consideration as being directed to non-elected subject matter.

Claims 55-95 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims 55 and 76 have been amended to recite that the mollusc to be repelled is from the family *Agriolimidae* or *Helicadae*. The originally filed disclosure did not disclose that all family member molluscs from *Agriolimidae* or *Helicadae* respond to the claimed repellent. In fact, there is no disclosure of such family taxonomy in the originally filed disclosure.

Art Unit: 1616

The only tenuous claim of basis that applicant can make is from the disclosed species of snails and slugs. *Deroceras* molluscs are members of the family *Limacidae*, *Cernuella* molluscs are members of the family *Hygromidae*, and *Helix* mollusks are members of the family *Helicidae*. Therefore, with respect to the family *Agriolimidae*, there is not even a basis for pulling such family taxonomic name from the originally filed disclosure. Even if applicant were to argue that there is a basis without verbatim original disclosure, it is the Examiner's position that applicant has not established sufficient explanation as to why the originally filed disclosure supplies adequate written descriptive support for *Agriolimidae* or *Helicada*.

Moreover, the Examiner would **not** agree that even if a few species that happen to belong to the families *Agriolimidae* or *Helicadae* were disclosed in the originally filed disclosure, that would be sufficient written descriptive support for the entire families of *Agriolimidae* and *Helicadae*. The Examiner has established that amongst other land inhabiting snail and slug species calcium oxalate has an effect that is opposite from the one intended by applicant's invention. Therefore, without having originally disclosed that all mollusc species belonging to the family *Agriolimidae* or *Helicadae* would be repelled by the inventive metal oxalates, subsequent amendment to recite the same must be determined as new matter that is without adequate written descriptive support.

Claims 76-81, 83, 85-88, and 92-94 are rejected under 35 U.S.C. 102(b) as being anticipated by Ikari et al. (EP 485213).

Art Unit: 1616

Ikari et al. explicitly disclose antifouling compositions that contain 1-50 wt% copper oxalate and two other antifoulant-active agents, including 0.1-45 wt% of a 1,2,4-triazole compound (see claims 1, 10-13; page 5, lines 23-26). It is noted for the record that 1,2,4-triazoles are known fungicides, such as the specifically disclosed penconazole and hexaconazole (compounds 6 and 7 on page 4; see also claim 3). The composition can be applied or coated to surfaces such as ship hulls, industrial facilities and power stations (page 2, lines 1-7 & 16; page 3, lines 9-11; page 5, lines 50-53) and conventional coating materials and mixtures are disclosed (page 5, lines 51-52); hence a coating is clearly disclosed. Binder materials such as "conventional paints," "anti-dripping agents," resins such as rosin, alkyd type resins, epoxy type resins, vinyl type resins are all disclosed (page 5, lines 30-31 & 37-39). Solvents such as xylene, toluene, naphtha, and cellosolve are disclosed, and it is noted that such solvents would have the effect of enabling even coverage (page 5, lines 40-41). It is noted that applicant's claim 88 reads on 0% diluent for even coverage.

For these reasons, the claims are anticipated. In re Sivaramakrishnan, 213 USPQ 441 (CCPA 1982). Applicant may argue that the amendatory phrase limiting the molluscs to family members of *Agriolimidae* or *Helicadae* must be given weight, but it is noted that the rejected claims here are directed to the composition per se. As such, the composition per se is anticipated because the prior art teaches compositions that contain all of the claim-required composition components. Since the prior art composition is directed to combating other pests such as marine molluscs, there is sufficient basis for accepting that the prior art composition per se could also function in

Art Unit: 1616

the manner now claimed by applicant. Just because applicant recites a new use for compositions that are encompassed by Ikari et al., that does not mean that Ikari et al. do not still anticipate applicant's composition claims. See MPEP 2112. Applicant's claims read on the prior art compositions, the prior art composition could function as claimed by applicant, so the claims are anticipated.

Claim 82 and 84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ikari et al.

It is noted that claim 84 depends on claim 83, which depends on claim 76, and claim 82 depends on claim 76. Both claims 76 and 83 have been rejected under 102(b) over Ikari et al. and the discussion in that ground of rejection regarding Ikari's teachings is incorporated herein by reference to avoid repetition.

The difference between the invention of claim 82 and Ikari et al. is that Ikari et al. do not expressly disclose copper oxalate in an aqueous suspension. However, conventional paint formulation is disclosed and that fairly suggests both oil-based and water-based formulations. Suspending agent as an additive (Ikari et al., page 5, line 30), particularly in view of insolubility of copper oxalate, suggests an aqueous suspension.

The difference between the invention of claim 84 and Ikari et al. is that Ikari et al. do not expressly state in verbatim language that the binder to facilitate adhesion of the metal oxalate onto the surface of an article comprises between 0.1-100% of the carrier. Given all that Ikari et al. teach, such concentration levels are fairly suggested. Binder

Art Unit: 1616

materials such as "conventional paints, "anti-dripping agents," resins such as rosin, alkyd type resins, epoxy type resins, vinyl type resins are all disclosed (page 5, lines 30-31 & 37-39). Normal use of such substances for their known functionality would have been within the claimed concentration levels.

Therefore, the claimed invention, as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, because an aqueous suspension of calcium oxalate is fairly suggested for the reasons stated above and the concentration range of the binder claimed in claim 84 is within a concentration that would have been necessary to achieve conventional paint, anti-dripping and/or resin functionality taught by Ikari et al.

Claims 76-79, 82, 88 are rejected under 35 U.S.C. 102(b) as being anticipated by Chemical abstracts 125:63666.

Chemical abstracts 125:63666 explicitly discloses an aqueous suspension of copper oxalate (see the first line and the last line).

It is of course recognized that the cited reference says nothing about repelling specific molluscs. However, the reference explicitly discloses a simple aqueous suspension that contains copper oxalate. There is nothing about such a suspension that indicates that it would not function as now claimed by applicant. The same composition with the same ingredients must necessarily mean that the same property must be present. Therefore, the claims are anticipated. See MPEP 2112.

Art Unit: 1616


Claims 76-78, 80, 82, 88 are rejected under 35 U.S.C. 102(b) as being anticipated by Chemical abstracts 95:186651.

Chemical abstracts 95:186651 explicitly discloses 30 g of ferric oxalate in 70 g of water is explicitly disclosed. This is 30 wt% ferric oxalate. Precipitates formed in 5 days, so this means a suspension was obtained, either before or after the 5 day storage.

It is of course recognized that the cited reference says nothing about repelling specific molluscs. However, the reference explicitly discloses a simple aqueous suspension that contains ferric oxalate. There is nothing about such a suspension that indicates that it would not function as now claimed by applicant. The same composition with the same ingredients must necessarily mean that the same property must be present. Therefore, the claims are anticipated. See MPEP 2112.

For these reasons, all claims are refused.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN D PAK whose telephone number is (703)308-4538. The examiner can normally be reached on Monday to Friday from 8 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703)308-4556. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1235.


JOHN PAK
PRIMARY EXAMINER
GROUP 1000